

Docket No. 22338-1205

U.S. Patent Application No. 10/081,280

REMARKS

The Applicant notes the indication by the Office that the restriction issued in connection with the present application, dated June 22, 2004, has been withdrawn.

Claims 46-66 are pending and subject to restriction by the Office.

The Office has imposed a restriction under 35 U.S.C. § 121 and is requiring an election between:

Group I: Claims 46-55 and 64-66, drawn to a method of blocking or inhibiting Apo-3 receptor using anti-Apo-3 antibody, classified in class 424, subclass 130.1.

Group II: Claims 56-63, drawn to a method of blocking or inhibiting Apo-3 receptor using Apo-3 receptor immunoadhesin, classified in class 424, subclass 192.1.

The Applicant respectfully traverses. One of skill in the art would understand the specification to define the term "antibody" such that it encompasses compositions such as immunoadhesins. *See e.g.*, page 17, lines 20-23. For example, the presently contemplated antibodies clearly encompass fusions with heterologous proteins. *See, e.g.*, page 18, lines 1-12. To provide a broader understanding of the subject matter, the Applicant directs the Office's attention to the specification, at page 48, line 26, where reference is provided to WO 89/02922 for a generic disclosure relating to immunoadhesins. WO 89/02922, in turn, describes immunoadhesins of the type contemplated in the present claims as comprising a form of antibody. *See, e.g.*, WO 89/02922 at page 12, line 16-page 13, line 9; page 14, lines 24-33 (cited portions enclosed).

Applicant would also like to point out that, in the present claims, there is a commonality of function of the antibodies (including immunoadhesins) in Groups I and II as capable of blocking or inhibiting Apo-3 receptor induced apoptosis in mammalian cells expressing Apo-3 or Apo-3 receptor activation of NF-kB in these mammalian cells. "[I]t is sufficient [to avoid restriction within a claim] if the members of the group are disclosed in the specification to *possess at least one property in common which is mainly responsible for their function in the claimed relationship*, and it is clear from their very nature or from the prior art that all of them possess this property." *In re Harnisch*, 631 F.2d 716, 723, 206 USPQ 300

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(CCPA 1980) (emphasis added). Here, each member of Groups I and II have at least a single property in common.

In addition, the Applicant respectfully points out that there is no significant search burden present in examining Groups I and II together. The Office appears to take the position that the search of the invention(s) of Groups I and II would be mutually exclusive. In this regard, the Applicant notes that both Groups have been classified as belonging to the same class (424). With regard to the subclass designations, class 130.1 (Group I) appears to exclude certain conjugates or complexes, not the immunoadhesins of the present claims. Accordingly, at the very least, a search of Group I would encompass the subject matter of Group II.

For the foregoing reasons, the Applicant respectfully asserts that the basis for restriction between Groups I and II is insufficient and the restriction may be properly withdrawn.

In the event that the instant Restriction Requirement is maintained despite the above discussion, Applicant hereby selects Group I (claims 46-55 and 64-66), with traverse for the reasons presented above.

Applicant expressly reserves their right under 35 U.S.C. § 121 to file a divisional application directed to the nonelected subject matter during the pendency of this application, or an application claiming priority from this application.

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In the unlikely event that the Patent Office determines that extensions and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or fees due to our Deposit Account No. 18-1260, referencing Docket No. 22338-1205. Any refund should be credited to the same account. The Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,



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